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REMARKS

This is a full and timely response to the outstanding Office action mailed October 28, 2005. Upon entry of the amendments in this response claims 1-34 are pending. More specifically, claims 1, 2, 8, 10, 15, 22, 24, and 29 are amended, and claims 30-34 are canceled. Claims 30-34 are canceled without prejudice or disclaimer. Applicant takes this action merely to reduce the number of issues and to facilitate early allowance and issuance of the present application. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if applicant so chooses, and does not intend to dedicate any of the canceled subject matter to the public. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 1, 3-8, 15-22, and 29-34 are rejected under 35 U.S.C. 103 (b) as allegedly being anticipated by *Williams* (U.S. Patent No. 5,057,935). Claims 2, 9-14, 23-28 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Williams* (U.S. Patent No. 5,057,935) in view of *Gupta* (U.S. Publication No. 2002/0194341). To the extent that these rejections have not been rendered moot by the cancellation of claims, they are respectfully traversed.

II. Claim 29 is Clearly Allowable

Applicant first contends that no reference or combination thereof discloses or suggests claim 29 and, therefore, claim 29 is clearly allowable. Applicant respectfully submits that because of the uniqueness of the claim limitations, and especially those added to its base claim through the foregoing amendment, claim 29 is clearly allowable over all prior references. It is respectfully requested that serious consideration be given to allowing claim 29.

III. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Patel spent with Applicant's representatives Jeff Kuester and Benjie Balser during a January 17, 2006, telephone discussion regarding the above-identified Office Action. Applicant believes that

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various features described in the patent application and recited in the claims, including a first and second notification option displayed in an email address list, were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Patel seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Patel carefully consider this amendment and response.

IV. Rejections Under 35 U.S.C. §102(b)

A. Claims 1 and 3-8

The Office Action rejects claims 1 and 3-8 under 35 U.S.C. §102(b) as allegedly being anticipated by *Williams* (U.S. Patent No. 5,057,935). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 as amended recites:

1. A method for selectively applying a delivery notification option to an email comprising:
 - listing email addresses;
 - selecting a plurality of said email addresses in the course of composing an email message;
 - maintaining a first list for a presence or absence of a first type of delivery notification option and a second list for a presence or absence of a second type of delivery notification option;*
 - selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses;
 - moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and
 - sending the email to said plurality of email addresses.

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(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Williams* does not disclose, teach, or suggest at least **maintaining a first list for a presence or absence of a first type of delivery notification option and a second list for a presence or absence of a second type of delivery notification option**. Therefore, *Williams* does not anticipate independent claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited references of record, dependent claims 3-8 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 3-8 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 3-8 are patentable over *Williams*, the rejection to claims 3-8 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 3-8 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 3-8 are allowable.

B. Claims 15-22

The Office Action rejects claims 15-22 under 35 U.S.C. §102(b) as allegedly being anticipated by *Williams* (U.S. Patent No. 5,057,935). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

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Independent claim 15 as amended recites:

15. An email system for providing selective application of delivery notification options to individual addresses in a single email, comprising:
means for listing email addresses;
means for selecting a plurality of said email addresses in the course of composing an email message;
means for maintaining a first list for a presence or absence of a first type of delivery notification option and a second list for a presence or absence of a second type of delivery notification option;
means for selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses;
means for moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and
means for sending the email to said plurality of email addresses.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 15 as amended is allowable for at least the reason that *Williams* does not disclose, teach, or suggest at least **means for maintaining a first list for a presence or absence of a first type of delivery notification option and a second list for a presence or absence of a second type of delivery notification option**. Therefore, *Williams* does not anticipate independent claim 15, and the rejection should be withdrawn.

Because independent claim 15 as amended is allowable over the cited references of record, dependent claims 16-22 (which depend from independent claim 15) are allowable as a matter of law for at least the reason that dependent claims 16-22 contain all the steps/features of

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independent claim 15. Therefore, since dependent claims 16-22 are patentable over *Williams*, the rejection to claims 16-22 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 15, dependent claims 16-22 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 16-22 are allowable.

C. Claims 29-34

The Office Action rejects claims 29-34 under 35 U.S.C. §102(b) as allegedly being anticipated by *Williams* (U.S. Patent No. 5,057,935). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 29 as amended recites:

29. An email system for selectively applying delivery notification options to an email having a plurality of addressees, comprising:

an email client operable to display an address list and to select addressees for an email; and

an email server in communication with the email client and connected to a network;

wherein at least one of the email client and the email server is operable to selectively apply a delivery notification option to one or more, but not all, of the addressees; and

wherein at least one of the email client and the email server is further operable to maintain a first list for a presence or absence of a first type of delivery notification option and a second list for a presence or absence of a second type of delivery notification option; and to move each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option.

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(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

Applicant respectfully submits that independent claim 29 as amended is allowable for at least the reason that *Williams* does not disclose, teach, or suggest at least wherein at least one of the email client and the email server is further operable to maintain a first list for a presence or absence of a first type of delivery notification option and a second list for a presence or absence of a second type of delivery notification option. Therefore, *Williams* does not anticipate independent claim 29, and the rejection should be withdrawn.

Because independent claim 29 as amended is allowable over the cited references of record, dependent claims 30-34 (which depend from independent claim 29) are allowable as a matter of law for at least the reason that dependent claims 30-34 contain all the steps/features of independent claim 29. Therefore, since dependent claims 30-34 are patentable over *Williams*, the rejection to claims 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 29, dependent claims 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 30-34 are allowable.

V. Rejections Under 35 U.S.C. §103(a)

A. Claim 2

The Office Action rejects claim 2 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Williams* (U.S. Patent No. 5,057,935) in view of *Gupta* (U.S. Publication No. 2002/0194341). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over the cited references of record, dependent claim 2 (which depends from independent claim 1) is allowable as a matter of law for at least the

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reason that dependent claim 2 contains all the steps/features of independent claim 1. Therefore, the rejection to claim 2 should be withdrawn and the claim allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claim 2 recites further features and/or combinations of features, as are apparent by examination of the claim itself, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claim 2 is allowable.

Additionally, with regard to the rejection of claim 2, *Gupta* does not make up for the deficiencies of *Williams* noted above. Therefore, claim 2 is considered patentable over any combination of these documents.

B. Claims 9-14

The Office Action rejects claims 9-14 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Williams* (U.S. Patent No. 5,057,935) in view of *Gupta* (U.S. Publication No. 2002/0194341). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 9 recites:

9. A method of selectively applying a delivery notification option to addressees in an email, comprising:

displaying an address book;
choosing addressees from the address book;
setting a flag indicating that more than one addressee has been chosen;
displaying an email delivery notification options selection window if said flag is set;
maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option;
selectively applying delivery notification options to each of the addressees;

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moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and sending the email.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 9 is allowable for at least the reason that the combination of *Williams* and *Gupta* does not disclose, teach, or suggest at least maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option. Even if *Gupta* discloses options associated with addresses in an address book, *Gupta* does not disclose at least two types of delivery notification options in the address book. *Williams* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 9, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 9 is allowable.

Because independent claim 9 is allowable over the cited references of record, dependent claims 10-14 (which depend from independent claim 9) are allowable as a matter of law for at least the reason that dependent claims 10-14 contain all the steps/features of independent claim 9. Therefore, the rejection to claims 10-14 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 9, dependent claims 10-14 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 10-14 are allowable.

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C. Claims 23-28

The Office Action rejects claims 23-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Williams* (U.S. Patent No. 5,057,935) in view of *Gupta* (U.S. Publication No. 2002/0194341). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 23 recites:

23. A system for selectively applying a delivery notification option to addressees in an email, comprising:

- means for displaying an address book;
- means for choosing addressees from the address book;
- means for setting a flag indicating that more than one addressee has been chosen;
- means for displaying an email delivery notification options selection window if said flag is set;
- means for maintaining a first list for a first type of delivery notification option and a second list for a second type of delivery notification option;*
- means for selectively applying delivery notification options to each of the addressees;
- means for moving each of the one or more email addresses with a delivery notification option applied to it into the first list, second list, or both lists corresponding to the selected delivery notification option; and
- means for sending the email.

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 23 is allowable for at least the reason that the combination of *Williams* and *Gupta* does not disclose, teach, or suggest at least **means for maintaining a first list for a presence or absence of a first type of delivery notification**

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option and a second list for a presence or absence of a second type of delivery notification option. Even if *Gupta* discloses options associated with addresses in an address book, *Gupta* does not disclose at least two types of delivery notification options in the address book. *Williams* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 23, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 23 is allowable.

Because independent claim 23 is allowable over the cited references of record, dependent claims 24-28 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 24-28 contain all the steps/features of independent claim 23. Therefore, the rejection to claims 24-28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 24-28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 24-28 are allowable.

VI. Miscellaneous Issues

Since independent claims 9 and 23 are traversed without amendment, the subsequent Office Action, should one be deemed necessary, should retain a non-final status.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-34 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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